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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/392,728	09/09/1999	KLAUS STOCKEMANN	SCH-1550-C1	1685

7590 01/08/2004

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EXAMINER

WEBMAN, EDWARD J

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 01/08/2004

24

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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DATE MAILED:

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 4/15/03
- ☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- ☒ Claim(s) 1-46, 48, 51-53 is/are pending in the application.
- Of the above, claim(s) 13, 14, 27, 28, 33-46 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-12, 15-26, 29-32, 48, 51-53 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 22
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

Art Unit: 1617

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-12, 19-26, 52, 53 are rejected under 35 U.S.C. 102(a) as being anticipated by Stockemann et al., DE 4344463A1 ('463).

Claims 1-12, 15-26, 52, 53 are not novel over the prior art ('463). See page 2, lines 61 to 68, page 3, lines 42 to 44, page 4, lines 1 to 19, page 5, lines 1 to 10, page 6, examples 1 to 3, claims 1, 3, 5, 6, 8, 9, 11 and 12.

Applicants' disclose dosages for the antagonists (page 9 lines 20-24) and the gestagens (page 10 lines 23-31) that overlap those disclosed in DE '463 (page 4 lines 33-37) and page 5 lines 9-11 respectively. DE '463 (examples 1-3, page 6) teaches numbers of dosage units for antagonist and Gestagen that overlap the claimed numbers. In fact, example 1 page 6 in DE '463 is identical to applicants' Diagram 1 on page 14.

As to the claimed amenhorrea, such must be attained in view of the fact that, as discussed above, the disclosed dosages overlap and the phases (see again DE '463 example 1 page 6 and applicants' diagram 1 page 14) are the same.

Applicants argue that Stockemann et al does not teach ovulation inhibitory doses. However, the dosages, as discussed above, overlap those disclosed. The limitation to ovulation inhibitory dose is merely an intended use. Contrary to applicants' contention, phases are disclosed, as cited above. ~~Applicants argue that Stockemann et~~

Art Unit: 1617

at lastly, applicants argue that Stockemann et al teach dosages and a regimen opposite to that claimed. However, as noted above, the dosages and phases of Stockemann et al overlap with those disclosed.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12, 15-26, 29-32, 48, 51-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stockemann et al., DE 4344463A1 (DE '463).

DE '463 is discussed above.

It would have been obvious to use a combination of competitive progesterone antagonist and gestagen as a contraceptive in view of DE '463.

As to the claimed kits, such are well known in the art.

That is, one of ordinary skill, even the layman, is cognizant of the convenience of contraceptive compositions provided in the kit form and the fact such kits are commercially available. Thus, it would be an obvious expedient to make the invention of DE '463 in kit form, including delineating pills in sets of 7 to indicate one week periods of time.

Applicants repeat their arguments against the 102 rejection. The examiner's rebuttal to those arguments is thus incorporated herein.

Applicants additionally assert there is no motivation for a kit. However, motivation has been provided.

No claims allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward J. Webman whose telephone number is 308-4432. The examiner can normally be reached on Monday-Friday 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Padmanabhan can be reached on 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1234.

Webman/tgd  
December 11, 2003

  
**EDWARD J. WEBMAN**  
**PRIMARY EXAMINER**  
**GROUP 1500**